

### **REMARKS**

Claims 1 – 19 are pending in the application. Claims 4 – 7, 10, 13 and 14 have been cancelled. Claims 1 and 11 have been amended. No new matter has been added by virtue of these amendments; support therefore can be found throughout the specification and original claims of the application.

Any cancellation of the claims should in no way be construed as acquiescence to any of the Examiner's rejections and was done solely to expedite the prosecution of the application. Applicant reserves the right to pursue the claims as originally filed in this or a separate application(s).

#### **Claim Rejections Withdrawn**

The rejection of claim 11 under 35 USC 112, second paragraph, has been withdrawn.

The rejection of claims 1 – 3, 6 – 7, 11 – 12 and 15 - 19 under 35 U.S.C. 102(b) as being anticipated by Boel et al. (US Patent 5,536,661) has been withdrawn.

#### **Rejection of Claims 1 – 3, 6 – 7, 11 – 12 and 15 - 19 under 35 U.S.C. 102(b)**

Claims 1 and 15 - 19 were rejected under 35 U.S.C. §102(b) as being anticipated by Minetoki et al. (Appl Microbiol Biotechnol, 1998: 50 p.459 – 467). Applicants respectfully traverse the rejection.

Claim 1 recites a modified promoter constructed by inserting a first DNA fragment including CCAATNNNNNN (a first base sequence: SEQ ID NO: 1) and a second DNA fragment including CGGNNNNNNNNNGG (a second base sequence: SEQ ID NO: 2) into a promoter, wherein the first DNA fragment and the second DNA fragment are combined as a pair, and in each pair, said first DNA fragment and said second DNA fragment are inserted so that they are arranged sequentially from the 5' end to the 3' end side of said promoter, wherein said first DNA fragment and said second DNA fragment are inserted at the 5'-end side that is upstream to a CCAAT sequence existing in said promoter or at the 3'-end side that is downstream to a SRE sequence existing in the promoter, and wherein the modified promoter is capable of functioning in a filamentous fungus.

To anticipate a claim, each and every element of the claim must be found in a single reference. This is discussed in the Manual of Patent Examining Procedure § 2131:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”  
Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The Minetoki et al. reference does not teach or suggest all the limitations of the instant claims. In particular, nowhere does the Minetoki reference expressly or inherently teach or suggest a modified promoter capable of functioning in a filamentous fungus according to the instant claims, where a first DNA fragment and a second DNA fragment are combined as a pair, and in each pair, said first DNA fragment and said second DNA fragment are inserted so that they are arranged sequentially from the 5' end to the 3' end side of said promoter, and **where said first DNA fragment and said second DNA fragment are inserted at the 5'-end side that is upstream to a CCAAT sequence existing in said promoter or at the 3'-end side that is downstream to a SRE sequence existing in the promoter region.**

The Examiner argues that “Minetoki et al. teach wherein a plurality of said first DNA fragments and a plurality of said second DNA fragments are inserted...and further to wherein the same number of said first DNA fragments and said second DNA fragments are inserted.” (Office Action, p.5). The Examiner argues that “Minetoki et al teach inserting multiple copies of Region IIIa sequence which contains the second base sequence ‘CGGAAATTTAAAGG’ inserted in tandem with the Region IIb sequence which contains the first DNA fragment including the CCAATNNNNNN’ sequence into the promoter region of a modified vector.” (Office Action, p.6).

Applicants direct the Examiner to Figure 2 of Minetoki, shown below, which schematically depicts the promoter as taught by the Minetoki reference.

Figure 2

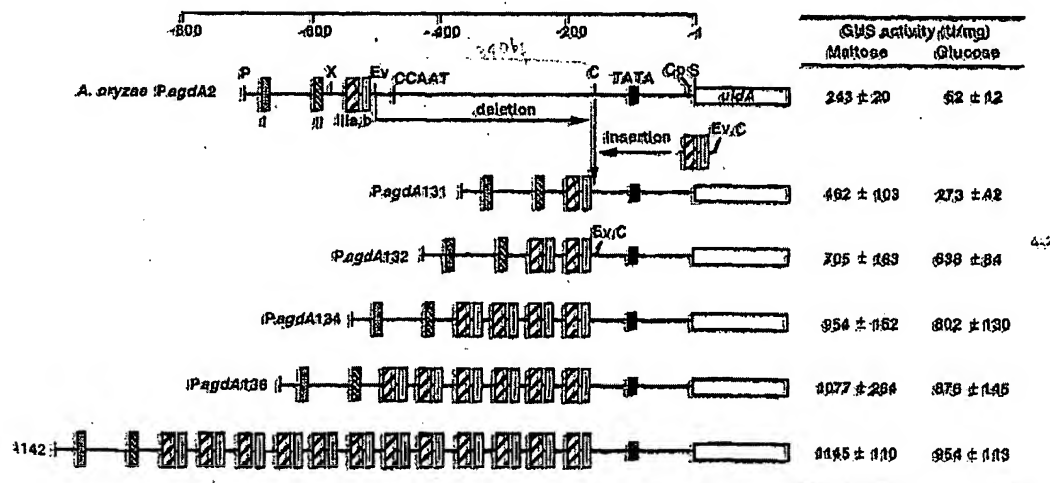
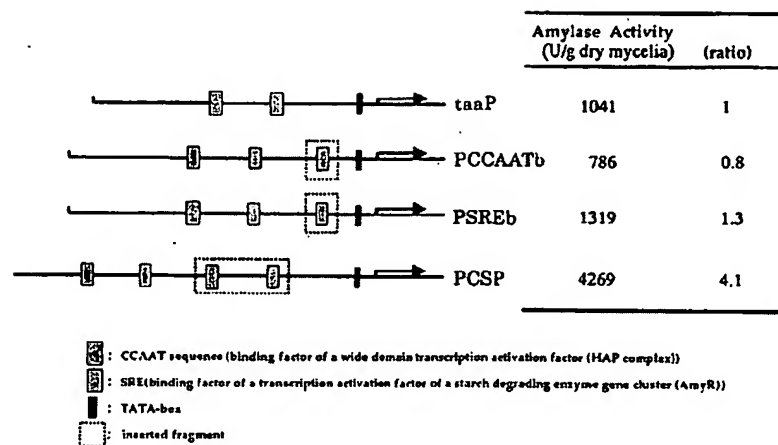


Figure 2 of Minetoki illustrates the location of the conserved elements (regions I, II, IIIa and IIIb) within the promoter region, as well as the CCAAT box and the TATA box. The Examiner argues that Region IIIa contains the sequence 'CGGAAATTTAAAGG' and that region "also reads on a full length SRE sequence." (Office Action, p.6). However, as clearly shown in Figure 2, **nowhere does Minetoki teach an existing CCAAT sequence and an existing SRE as set forth in the instant claims.**

In comparison, Applicants direct the Examiner to, for Example, Figure 4 of the instant Application, which shows a schematic of insertion positions of a CAAT sequence of SRE in exemplary modified promoters of the invention. Figure 4 is shown below.

Figure 4



In Figure 4, the wild type promoter (shown on top, TaaP), has both the CCAAT sequence and SRE, while the bottom construct, as instantly claimed, contains the originally existing CCAAT and SRE and a **CCAAT sequence and SRE inserted at the same time** (inserted fragment show in box). When comparing Figure 2 (of Minetoki) and Figure 4 of the instant Application, it is clear that the promoter as taught by the Minetoki et al. reference and the promoter as instantly claimed are different.

Moreover, the Examiner argues that “Minetoki et al teach inserting multiple copies of Region IIIa sequence...in tandem with the Region IIIb sequence which contains the first DNA fragment including the CCAATNNNNNN’ sequence into the promoter region of a modified vector.” (Office Action, p.6). Applicants direct the Examiner to Figures 1 and 2 of the Minetoki reference. It is apparent from Figures 1 and 2 that IIIa (including a sequence corresponding to the second DNA fragment) located at 5'-end side and IIIb (including a sequence corresponding to the first DNA fragment) located at 3'-end side, are paired. Thus, the arrangement of elements in the promoter region as taught by the instant invention is not taught by the Minetoki reference. As pointed out by the Examiner, in the constructs depicted in Figure 2 of Minetoki et al., IIIb and IIIa are arranged, in part, sequentially from the 5'-end side to the 3'-end side. However, IIIb at the 5'-end side and IIIa at the 3'-end are not paired. If, as the Examiner asserts, IIIb at the 5'-end side and IIIa at the 3'-end are paired, unpaired IIIa and IIIb remain, which is not possible according to the Examiner’s interpretation of the reference.

Thus, the Minetoki reference does not teach or suggest a modified promoter where a first DNA fragment and a second DNA fragment are inserted at the 5'-end side that is upstream to a CCAAT sequence existing in said promoter or at the 3'-end side that is downstream to a SRE sequence existing in the promoter region.

Accordingly, the Minetoki reference does not teach the limitations of the instant claims. Applicants respectfully request that the rejection be withdrawn. .

**Rejection of Claims 1 – 3, 7, 11 – 12, and 15 - 19 Under 35 USC 103(a)**

Claims 1 – 3, 7, 11 – 12, and 15 - 19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Minetoki et al., as applied to claims 1, 7 – 9 and 15 – 19 above, and further in view of Boel et al. (US Patent 5,536,661). Applicants respectfully traverse the rejection.

Claim 1 was set forth above.

As discussed above, the Minetoki reference fails to teach all the elements of the invention as instantly claimed. In particular, the Minetoki et al. reference fails to teach a modified promoter where a first DNA fragment and a second DNA fragment are inserted at the 5'-end side that is upstream to a CCAAT sequence existing in said promoter or at the 3'-end side that is downstream to a SRE sequence existing in the promoter region.

The Boel reference does not cure the defects of the Minetoki reference. Nowhere in the Boel reference is there teaching or suggestion of a modified promoter with an existing CCAAT sequence and an existing SRE as instantly claimed. Therefore, the teachings of the cited art, when combined, do not result in the claimed invention.

Accordingly, Applicants request that the rejection be withdrawn.

**CONCLUSION**

Early consideration and allowance of the application are earnestly solicited. If a telephone conference with the Applicants' Agent would expedite allowance of this application, the Examiner is urged to contact the undersigned.

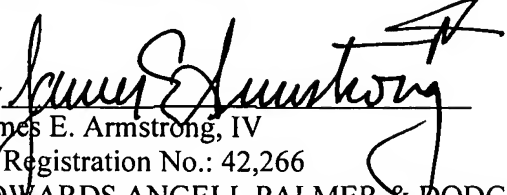
Application No. 10/505,171  
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If additional fees are due in connection with this response, Please charge our Deposit  
Account No. 04-1105.

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